

Application Serial No. 09/896,653
Amendment Dated December 27, 2005
Reply to Office Action of June 27, 2005

REMARKS/ARGUMENTS

Reconsideration of the rejection is respectfully requested in view of the following comments.

Claims 1-44 are pending in the present application. Claims 1-24 and 36-44 have been allowed. Claims 25-35 are rejected in the office action (although the office action inadvertently states 25-25 as being rejected).

The allowability of claims 1-24 and 36-44 is noted with appreciation. The rejection of claims 25-35, however, is traversed. No further amendments are believed necessary or warranted. The Examiner's attention is respectfully directed to the following specific comments regarding the rejections of claims 25-35.

Claim Rejections – 35 USC § 102

Claims 25, and 27-32 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,657,702 to *Chui et al.* With regard to independent claim 25, the Examiner indicated that *Chui* discloses a method for processing and printing electronic images on a medium comprising steps of: a) receiving an electronic image file (col. 10, lines 45-51); b) associating identification information with the electronic image file (col. 12, lines 15-20); c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information (col. 14, lines 34-38); d) printing the composite image from the composite image file on a medium, the composite image including an image and a first symbol, the first symbol including the identification information (co. 14, lines 34-38); e) extracting the identification information from the first symbol (col. 14, lines 20-23); and f) printing the identification information read from the first symbol on the medium (col. 14, lines 34-38).

Claim 25 and 33-35 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,646,754 to *Redd et al.* With regard to claim 25, the Examiner asserted that *Redd*

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discloses an annotation printer apparatus (print lab 600) for processing images on a medium and printing information thereon comprising: a) means (barcode reader 633, 636) for reading a plurality of first symbols existing on the medium, wherein each of the first symbols corresponds to one of a plurality of images existing on the medium, the first symbol including identification information (col. 21, lines 61-65, col. 26, lines 9-55); b) means (printer 622, backprinter 634) for printing identification information read from each of the first symbols, wherein the identification information read from each of the first symbols is printed proximate to the image and first symbol to which it correspond (col. 17, line 51 – col. 18, line 15); and c) means (scheduler 608) for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of each second symbol (col. 19, line 26 – col. 20, line 33).

These rejections are respectfully traversed. For reasons shown below, independent claim 25 is not anticipated by either the *Chui* patent or the *Redd* patent.

Summary of the Present Invention

The present invention pertains to systems for printing electronic images, in particular photographic images. More particularly, the inventive aspects relate to the manner in which a symbol (e.g. containing identification information, an annotation, etc.) relating to each image are printed (e.g. as a bar code) on the same side of the medium as the image itself, associated with that particular image. This symbol is read from the front or first side of the medium, typically in a later processing step, and used to print other information such as identification information, an annotation, etc. on the reverse side (backprinting). Among other things, this allows high speed printing and processing of the medium, for example on continuous rolls, followed by later backprinting of the other information on the reverse side. As will be shown, these aspects are not disclosed, taught, or suggested by either the *Chui* patent or the *Redd* patent, taken singularly or in combination.

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Comments Regarding Specific Claims

Claim Rejections – 35 U.S.C. §102(e): Chui

Claims 25, and 27-32 were rejected as anticipated by the patent to *Chui*. The Examiner asserted that *Chui* discloses a method for processing and printing electronic images on a medium comprising steps of: a) receiving an electronic image file (col. 10, lines 45-51); b) associating identification information with the electronic image file (col. 12, lines 15-20); c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information (col. 14, lines 34-38); d) printing the composite image from the composite image file on a medium, the composite image including an image and a first symbol, the first symbol including the identification information (col. 14, lines 34-38); e) extracting the identification information from the first symbol (col. 14, lines 20-23); and f) printing the identification information read from the first symbol on the medium (col. 14, lines 34-38).

Respectfully, the applicant disagrees with the Examiner's interpretation of the foregoing citations and traverses the rejection. Specifically, the Examiner appears to be relying on col. 14, lines 20-23 for the proposition that identification information may be "read" from the first symbol. The cited lines in the *Chui* patent discuss how an individual end-user or consumer ("print recipient" in the patent) may look at or read information printed on the image to, perhaps, order duplicates of the same picture. This does not meet the claim limitations of "means for reading a plurality of first symbols existing on a first surface of the medium ..." or "means for printing identification information read from each of the first symbols on a second surface of the medium, wherein the identification information read from each of the first symbols is printed on the reverse side of the image and first symbol to which it corresponds."

The Examiner cannot properly read either of these "means for ..." claim elements to be anticipated by a consumer reading information printed on the image for re-ordering purposes. That is not how 35 U.S.C. § 112, sixth paragraph, is meant to be applied in rejecting claims.

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In the system described in the present application, identification information is read from the first symbol on the first surface and then used to print the identification information on the reverse side (second surface)(e.g. in claim 25). In the *Chui* patent, the information is “extracted” or read by an end user, for the purpose of re-ordering prints, for example. It is respectfully submitted that the citation relied upon by the Examiner in finding anticipation has nothing to do with a properly-interpreted “means for reading a plurality of first symbols existing on a first surface ...” or “means for identification information read from each of the first symbols on a second surface of the medium”

For this reason alone, claim 25 is not anticipated by *Chui*.

The Examiner also cites col. 14, lines 34-38 of *Chui* for the proposition that the information read from the first symbol on the medium is or can be printed. The reference discusses that the information drawn from one image can be used to print a second image (“the automatic response system could use the entered unique re-order number to generate an order for the particular print identified by the re-order number and then have the print delivered to the recipient identified by the re-order number”)(emphasis added). Again, this citation does not refer to extracting or reading the information from the first symbol, and printing the information read from the first symbol on a second surface of the same medium.

The applicant respectfully requests that the Examiner withdraw the rejection of independent Claim 25 in light of the foregoing argument.

The applicant further respectfully requests that the Examiner accordingly withdraw the rejection of dependent claims 27-32, under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (holding that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious). Applicant however reserves the right to argue separate patentability of certain dependent claims should that become necessary.

Claim Rejections – 35 U.S.C. §102(e): Redd

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Claims 25, and 33–35 were rejected as anticipated by the *Redd* patent. The Examiner asserted that *Redd* discloses an annotation printer apparatus (print lab 600) for processing images on a medium and printing information thereon comprising: a) means (barcode reader 633, 636) for reading a plurality of first symbols existing on the medium, wherein each of the first symbols corresponds to one of a plurality of images existing on the medium, the first symbol including identification information (col. 21, lines 61-65, col. 26, lines 9-55); b) means (printer 622, backprinter 634) for printing identification information read from each of the first symbols, wherein the identification information read from each of the first symbols is printed proximate to the image and first symbol to which it correspond (col. 17, line 51 – col. 18, line 15); and c) means (scheduler 608) for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of each second symbol (col. 19, line 26 – col. 20, line 33).

Respectfully, the applicant disagrees with the Examiner's interpretation of the citations of *Redd* and traverses the rejection. Specifically, the Examiner cites col. 17, line 51 – col. 18, line 15 and col. 26, lines 30-36 for the proposition that the identification information read from each of the first symbols is printed proximate to the image and first symbol to which it corresponds. These portions of *Redd* relate to printing of “non-image information.” Presumably, the Examiner is reading *Redd*'s “non-image information” to correspond to the claim term “first symbol ... identification information.”

Accordingly, it now appears that the Examiner is no longer relying on the “destination identifier print 900” (col. 17, line 10; FIG. 7 of *Redd*) as corresponding to the claimed “first symbol including identification information” and is now relying upon the “non-image information.”

Redd admittedly says that “non-image information may be printed on the back.” (Col. 17, line 64). However, this non-image information, although it may be printed on the back, is nowhere described as being derived by reading such information from a first surface with a reading means to obtain identification information, and then printing such identification

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information on a second surface with a printing means. *Redd* simply says that non-image information may be printed on the back without saying how such information is derived.

Therefore, *Redd* simply does not disclose, teach or suggest a “means for reading ... first symbol including identification information” (or any information, for that matter) and then using that information to print something on the reverse side. Accordingly, the Examiner’s application of this portion of *Redd* does not meet the limitations of claim 25 that recites a “means for reading a plurality of symbols existing on a first surface ...” or of the “means for printing identification information” and therefore does not anticipate it.

The Examiner also cites *Redd* col. 19, line 26 – col. 20, line 33 as teaching a means for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of each second symbol. Again, in all of these lines there is no discussion of printing identification information read from first symbols on a second surface. These lines teach the sorting process in order to streamline and optimize the production. It is a means for regulating movement of the medium through the apparatus, but it does not teach anything that could be used to coordinate the reading of information from a first symbol, and printing the information read from a first symbol onto a second surface of the medium.

For the foregoing reasons, it is submitted that claim 25 is not anticipated by either *Chui* or *Redd*, and the applicant respectfully requests that the Examiner withdraw the rejection. The applicant further respectfully requests that the Examiner accordingly withdraw the rejection of dependent Claims 33–35 under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (holding that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious). Applicant however reserves the right to argue separate patentability of certain dependent claims should that become necessary.

Claim Rejections – 35 U.S.C. § 103

Claims 26 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Chui* in view of *Redd*. The Examiner indicated that *Chui* discloses wherein the medium is printed, but does not

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clearly teach that the medium is a continuous roll of photographic paper. *Redd* was cited as disclosing a system for backprinting image prints where the medium is a continuous roll of photographic paper. The Examiner concluded it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified *Chui* to include the print medium being a continuous roll of photographic paper as taught by *Redd*. The Examiner further asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified *Chui* by the teaching of *Redd* to allow successive printing onto successive portions of a roll of print paper as taught by *Redd*.

This is a dependent claim. Under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. As clearly illustrated above in connection with the rejections under 35 U.S.C. § 102, there is no disclosure, teaching, or suggestion in either *Chui* or *Redd*, taken singularly or in combination, of an invention that involves printing a composite image including an image and a first symbol (the first symbol including identification information or other information) on a first surface of a medium, extracting or reading the information from the first symbol, and printing the information read from the first symbol on a second surface of the medium. Accordingly, because independent Claim 25 is not anticipated and not obvious from the references, the corresponding and associated dependent Claim 26 should also be patentable.

Conclusion

For the foregoing reasons, it is respectfully submitted that all claims should be allowable.

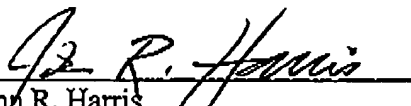
The foregoing is presented as a full and complete response to the Office Action mailed June 27, 2005, and is believed to have placed all claims in condition for allowance. Such action is courteously solicited. If any issues remain that can be resolved by telephone, the Examiner is respectfully requested to contact the undersigned at 404-233-7000.

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It is now believed that the application is in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,
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